



03 MAY 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MCKELLAR IP LAW, PLLC
784 SOUTH POSEYVILLE ROAD
MIDLAND MI 48640

In re Application of	:	
ARMSTRONG et al.	:	
Application No.: 10/559,399	:	DECISION
PCT No.: PCT/US04/18074	:	
Int. Filing Date: 08 June 2004	:	
Priority Date: 09 June 2003	:	
Attorney Docket No.: DC-5067US	:	
For: MAGNETIC SEPARATOR APPARATUS	:	

This is a decision on applicants' submission filed 06 January 2006 in the United States Patent and Trademark Office (USPTO), which has properly been treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 08 June 2004, applicants filed international application PCT/US04/18074, which designated the United States and claimed a priority date of 09 June 2003. A copy of the international application was communicated from the International Bureau to the USPTO on 23 December 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 09 December 2005.

On 05 December 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 06 January 2006, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors and a copy of a letter from Mr. Paul Fears to Mr. Frank Perrin.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Item (1) has not been met. The petition fee is \$200 rather than \$130.

Item (3) has been met.

Item (2) has not been met. It is alleged that the non-signing inventor Stephen John Dobney cannot be found. MPEP 409.03(d), item I, states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

...

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts.

Here, such a statement of facts has not been provided. Additionally, the only documentary evidence provided is a letter concluding that Mr. Dobney could not be reached.

Item (4) has not been met. The declaration filed 06 January 2006 is not in compliance with 37 CFR 1.497(a)-(b). Each executed declaration must be complete. For example, each executed declaration must identify all of the inventors. Here it is not clear that any of the inventors signed a complete declaration. The declaration pages are not numbered and the names of the inventors seem to be randomly set forth on the different pages of the declaration: one page lists one inventor; another page lists four inventors; and another page lists two inventors. There are two copies of the page listing two inventors, one signed by each inventor listed. Applicants must submit either a single declaration executed by all of the inventors, with the exception of any non-signing inventors, or in the alternative a copy of the entire declaration for each signed declaration. Additionally, the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date is required.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer

Legal Examiner

PCT Legal Affairs

Office of Patent Cooperation Treaty

Legal Administration

Telephone: (571) 272-3301

Facsimile: (571) 273-0459